



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/876,276	06/16/1997	JAY SHORT	09010/020001	4852

28213 7590 04/28/2003

GARY CARY WARE & FRIENDENRICH LLP
4365 EXECUTIVE DRIVE
SUITE 1100
SAN DIEGO, CA 92121-2133

EXAMINER

STEADMAN, DAVID J

ART UNIT	PAPER NUMBER
----------	--------------

1652

DATE MAILED: 04/28/2003

34

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

08/876,276

Applicant(s)

SHORT ET AL.

Examiner

David J. Steadman

Art Unit

1652

--Th MAILING DATE of this communication appears on the cover sheet with th correspondence address --

THE REPLY FILED 31 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: 22-34,36 and 38-46.Claim(s) rejected: 19-21,35 and 37.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Application/Control Number: 08/876,276

Page 2

Art Unit: 1652

ADVISORY ACTION

- [1] Claims 19-46 are pending in the application.
- [2] Claims 19-21, 35, and 37 stand finally rejected.
- [3] Claims 22-34, 36, and 38-46 are objected to as being dependent upon a rejected base claim.
- [4] Applicant's amendment to claim 19 in Paper No. 33, filed 03/31/03, is acknowledged and has been entered into the record.
- [5] The request for reconsideration has been considered but does not place the claims in condition for allowance for the reasons described below.
- [6] The rejection of claims 19-21, 35, and 37 under 35 U.S.C. 102(b) as being anticipated by Abeijon et al. (*Proc Natl Acad Sci USA* 93:5963-5968, 1993) is maintained. The rejection was fully explained in a previous Office action (see item 8 of Paper No. 28). Applicant argues (beginning at page 3 of Paper No. 33) the *K. lactis* mutant cells transformed with the wild-type *K. lactis* genomic library contain mutant DNA as well as wild-type DNA and therefore the mutant *K. lactis* clones do not contain "naturally occurring" DNA. Applicant concludes that because the *K. lactis* mutant clones of Abeijon et al. do not contain "naturally occurring" DNA, the method of Abeijon et al. does not anticipate the claimed method. Applicant's argument is not found persuasive. The DNA used to transform the *K. lactis* mutant strain was isolated from a wild-type *K. lactis* strain, and thus, a skilled artisan would recognize this DNA to be "naturally occurring", i.e., wild-type or non-mutant DNA. Abeijon et al. teaches the *K. lactis* mutant strain is transformed with wild-type *K. lactis* genomic DNA (page 5963, right column, lines 14 and 15) and thus, these clones as taught by Abeijon et al. contain "naturally occurring" DNA. Thus, Abeijon et al. teaches all limitations of the claimed invention and therefore anticipates claims 19-21, 35, and 37 as written.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The Examiner can normally be reached Monday-Thursday from 6:30 am to 5:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX number for this Group is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman, Ph.D.

Application/Control Number: 08/876,276

Page 3

Art Unit: 1652

Patent Examiner

Art Unit 1652

Rebecca Prouty

REBECCA E. PROUTY
PRIMARY EXAMINER
GROUP 1652
1603